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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.	
10/589,051	03/26/2007	Katja Berg-Schultz	22234 US (C038435/0199186	5471	
Stephen M. Har	7590 03/18/200 °ac z	EXAMINER			
BRYAN CAVE			MABRY, JOHN		
1290 Avenue of the Americas New York, NY 10104			ART UNIT	PAPER NUMBER	
,				1625	
			MAIL DATE	DELIVERY MODE	
			03/18/2009	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)			
	10/589,051	BERG-SCHULTZ ET AL.			
Office Action Summary	Examiner	Art Unit			
	JOHN MABRY	1625			
The MAILING DATE of this communication app	ears on the cover sheet with the c	orrespondence address			
Period for Reply					
A SHORTENED STATUTORY PERIOD FOR REPLY WHICHEVER IS LONGER, FROM THE MAILING DA - Extensions of time may be available under the provisions of 37 CFR 1.13 after SIX (6) MONTHS from the mailing date of this communication. - If NO period for reply is specified above, the maximum statutory period w - Failure to reply within the set or extended period for reply will, by statute, Any reply received by the Office later than three months after the mailing earned patent term adjustment. See 37 CFR 1.704(b).	ATE OF THIS COMMUNICATION 36(a). In no event, however, may a reply be tim vill apply and will expire SIX (6) MONTHS from cause the application to become ABANDONE	N. nely filed the mailing date of this communication. D (35 U.S.C. § 133).			
Status					
1)⊠ Responsive to communication(s) filed on <u>08 De</u>	ecember 2008.				
	action is non-final.				
·					
closed in accordance with the practice under E	x parte Quayle, 1935 C.D. 11, 45	53 O.G. 213.			
Disposition of Claims					
4) Claim(s) <u>1-13 and 15-17, 18-21</u> is/are pending in the application.					
4a) Of the above claim(s) is/are withdrawn from consideration.					
5) Claim(s) is/are allowed.					
6)⊠ Claim(s) <u>1-13 and 15-17</u> is/are rejected.					
7) Claim(s) is/are objected to.					
8) Claim(s) are subject to restriction and/or	r election requirement.				
Application Papers					
9) The specification is objected to by the Examine	r.				
10) ☐ The drawing(s) filed on is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.					
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).					
Replacement drawing sheet(s) including the correct	ion is required if the drawing(s) is obj	jected to. See 37 CFR 1.121(d).			
11)☐ The oath or declaration is objected to by the Ex	aminer. Note the attached Office	Action or form PTO-152.			
Priority under 35 U.S.C. § 119					
12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).					
a) All b) Some * c) None of:					
1. Certified copies of the priority documents have been received.					
2. Certified copies of the priority documents have been received in Application No					
3. Copies of the certified copies of the priority documents have been received in this National Stage					
application from the International Bureau (PCT Rule 17.2(a)).					
* See the attached detailed Office action for a list of the certified copies not received.					
Attachment(c)					
Attachment(s) 1) Notice of References Cited (PTO-892)	4) Interview Summary	(PTO-413)			
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Da	ate			
Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date	5) Notice of Informal P 6) Other:	atent Application			

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Response to Amendment(s)

Applicant's response on December 8, 2008 filed in response to the Office Action dated August 4, 2008 has been received and duly noted.

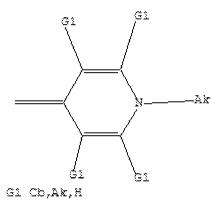
Applicant elected Example 1 as the elected species in the response to restriction requirement. The elected species falls within the scope of Group I:

Due to Applicant's elected species falling within the Scope of Group I, Examiner search was governed according to the variables of elected species. Examiner inadvertently did not communicate this in previous action.

In Examiner's further restriction requirement, compounds of Formula I, where R1 and R2 = cyano, is classified in class 546, subclasses 230 and 330. This is evidence of distinct and separate groups.

The following is a search which encompasses the scope of Group I. This search was so large that it did not run to completion (see underlined section below). This is evidence of a search burden.

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Structure attributes must be viewed using STN Express query preparation.

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SAMPLE SEARCH INITIATED 09:42:19 FILE 'REGISTRY'
SAMPLE SCREEN SEARCH COMPLETED - 21961 TO ITERATE

9.1% FROCESSED 2000 ITERATIONS

INCOMPLETE SEARCH (SYSTEM LIMIT EXCEEDED)

SEARCH TIME: 00.00.01

FULL FILE PROJECTIONS: ONLINE **COMPLETE**
BATCH **COMPLETE**

PROJECTED ITERATIONS: 430349 TO 448091 PROJECTED ANSWERS: 1811 TO 2063

Examiner has met the requirements of a proper restriction requirement.

Additionally, this application is filed under 371 and unity of invention was properly broken (see restriction requirement, pages 4 and 5 – dated 3/25/08).

In view of this response, the status of the rejections/objections of record is as follows:

Status of the Claims

Claims 1-13 and 15-17 are pending and rejected.

Claims 14 and 22 have been cancelled.

Claims 18-21 are directed towards non-elected subject matter.

Specification Objections

Objection of claim 15 regarding the valency issues has been overcome in view of Applicants amendments to the Specification.

35 USC § 112 Rejection(s)

The 112-2nd rejection of claim 15 regarding the valency issues has been overcome in view of Applicants amendment to the claims.

The 112-1st rejection of claim 11 regarding the term "tristromethamine" has been overcome in view of Applicants amendment.

The 112-1st rejection of claims 1-13 and 15-17 regarding the scope of enablement for "R3 – R6" have been overcome in view of Applicants amending the claims. However, the 112-1st rejection over the variables X and Y have <u>not</u> been overcome and remain rejected.

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Applicant is not enabled to be the description below.

X is

an alkyl, alkylaryl or alkyl cycloalkyl group containing 1
to 20 carbon atoms and optionally 1 to 10 hetero atoms, and
comprising at least one group including at least one hetero
atom which is positively or negatively charged, and

Y is a counterion.

The Applicant is enabled for C1-C5 alkyl groups which are interrupted by 1-2 heteroatoms wherein heteroatoms are N, O, S and P and X where X is K, Na, halogen, Li but is not enabled for the entire scope as claimed.

Applicant claims "alkyl, alkylaryl and alkylcycloalkyl groups optionally containing 1-10 heteroatoms". This is not the proper term to describe an alkyl group. For example, an ethyl alkyl group comprising of an oxygen is not an alkyl group - it would be an ether.

Applicant is not enabled for Y being every counter ion that chemically exists.

Examiner described above which counterions Applicant is enabled. According to

Hawley's Condensed Chemical Dictionary, 14th Edition, the term "ion" is defined as:

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ion. An atom or radical that has lost or gained one or more electrons and has thus acquired an electric charge. Positively charged ions are cations and those having a negative charge are anions. An ion often has entirely different properties from the element (atom) from which it was formed. In sodium chioride solution, sodium exists as sodium ion (Na'), i.e., sodium atoms that have lost one electron. The chlorine is present as chloride ion (Cl'), i.e., chlorine atoms that have gained one electron. Copper sulfate solution contains copper ion (Cu^{**}), i.e., copper atoms that have lost two electrons, and sulfate ion (SO,"), i.e., sulfate radicals that have gained two electrons. Ions occur in water solution or in the fused state (except in the case of gases). Compounds that formions are called electrolytes because they enable the solution to conduct electricity. Ion formation causes an abnormal increase in the boiling point of water and also lowers the freezing point, the extent depending on the concentration of the solution. Ions are also formed in gases as a result of electrical discharge.

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Applicant is clearly not enabled for this term. Additionally, claimed term would include organic ions as well which there is an enormous amount of possibilities in which Applicant is not enabled.

Additionally, it is Examiner's interpretation that the terms "alkylaryl and alkylcycloalkyl" is bonded through the alkyl group. If Applicant has another intended interpretation, please explicitly and clearly explain definition.

Claim Rejections - 35 USC § 102

Claims 1-5, 9 and 12-13 rejections are withdrawn under 35 U.S.C. 102(b) as being anticipated by Matsubayashi et al; Tanaka et al; and Urayama et al in view of Applicant's amendments and remarks.

Claim Rejections - 35 USC § 103

Claims 1-10, 12-13 and 16-17 rejections are withdrawn under 35 U.S.C. 103(a) as being unpatentable over Berg-Schultz et al (WO '183) et al in view of Applicant's remarks.

Obviousness-Type Double Patenting Rejection(s)

The obviousness-type double patenting rejected has been overcome over US Berg-Schultz et al (US '278).

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Conclusion

Applicant is respectfully reminded that it is required that all claims be amended to

elected group. Examiner also warns Applicant not to introduce new matter when

amending.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to John Mabry, PhD whose telephone number is (571)

270-1967. The examiner can normally be reached on M-F from 9am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's

primary examiner can be reached at (571) 272-0684, first, or the Examiner's supervisor,

Janet Andres, PhD, can be reached at (571) 272-0867. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

/John Mabry/ Examiner

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/Rita J. Desai/ Primary Examiner, Art Unit 1625 Application/Control Number: 10/589,051

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